

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Catherine LIN-HENDEL

Ser. No.: **09/577,190**

Filed: **May 23, 2000**

For: **A METHOD AND SYSTEM FOR ONE-
CLICK NAVIGATION AND BROWSING OF
ELECTRONIC MEDIA AND THEIR
CATEGORY STRUCTURE AS WELL AS
TRACKING THE NAVIGATION AND
BROWSING THEREOF**

Group Art Unit: **2179**

Examiner: **Steven B. THERIAULT**

Attorney File No.: **LH 004**

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Examiner's Answer Mailed On:
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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450**

REPLY BRIEF

This paper is Applicant's reply to the Examiner's answer mailed on October 25, 2010 (the "Examiner's Answer"), in the above-referenced patent application. The Reply Brief is being filed within two months of the mailing date of the Examiner's Answer. Therefore, the Reply Brief is timely. In accordance with MPEP § 1208(I), the Reply Brief includes these identification and introductory pages, status of claims page, grounds of rejection to be reviewed on appeal page, and reply argument pages responsive to the Examiner's Answer.

No fees are needed to file this Reply Brief. If the undersigned attorney is mistaken in this regard, authorization is hereby granted to charge all small entity fees necessary to file this Reply

Brief to Deposit Account No. 50-3196.

Applicant relies on the Appeal Brief for exposition of the grounds for reversal of the rejections, and takes this opportunity to respond to the Examiner's Answer. Applicant intends this Reply Brief to supplement the Appeal Brief, rather than to replace it.

I
STATUS OF CLAIMS

The status of claims in the instant application is as follows:

Claims 1-22 and 29-54 are pending in the application.

Claims 1-22 and 29-54 have been rejected.

Applicant appeals from the rejections of claims 1-22, 29, 30, and 52-54.

II
GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-22, 29, 30, and 52-54 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gennaro *et al.*, U.S. Patent Number 5,742,768 (“Gennaro” in the Appeal Brief and in this Reply Brief) in view of Chang *et al.*, U.S. Patent Number 6,091,415 (“Chang” in the Appeal Brief and this Reply Brief).

III **ARGUMENT**

A. Reply to Contentions in the Examiner's Answer

Independent claim 1 stands rejected as being unpatentable over Gennaro and Chang. The claim is set forth below with selected limitations underlined for easy reference:

1. A system for navigating and browsing electronic media, comprising:

a device enabling viewing of digitally stored information, the device being configured to display at least portions of a categorization structure for substantially all of a website having a plurality of nested cascading category levels, each category level of the plurality of nested cascading category levels comprising a plurality of category titles of electronic media content stored on at least one storage device, each category title having a selectable link-token to the stored content for said each category title, said each category title also being coupled to a nested subcategory structure of said each category title, the nested subcategory structure of said each category title comprising link-tokens of category titles wherein said each category title and the category titles in the different plurality of category levels are able to be browsed independently of having to select and retrieve the stored content for any title from the at least one storage device, wherein the categorization structure enables a user viewing content of any category title in the categorization structure to retrieve content of any other category title in the categorization structure using a single retrieval command.

In the Appeal Brief, we focused on the following limitations of claim 1, limitations that are neither taught nor suggested by the cited references:

1. *said each category title and the category titles in the different plurality of category levels are able to be browsed independently of having to select and retrieve the stored content for any title, and*

2. the categorization structure enables a user viewing content of any category title in the categorization structure to retrieve content of any other category title in the categorization structure using a single retrieval command.

These limitations require that the system enable retrieval of any title (page) from any other page through a single retrieval command, without retrieval of any intermediate page(s). Because there is a plurality of nested cascading category levels, the single command retrieval must be enabled in both directions of navigation within the website, *i.e.*, going up one or more levels, as well as going down one or more levels. Moreover, because each level has a plurality of titles or pages, the single command retrieval must be enabled from a second level title in a first path to another second level item in a second path. (“Path” here refers to link(s) from a page on a higher level to a page on a lower level.)

Consider a simple example with a top level having pages X and Y, where X contains links to lower level pages x1 and x2, and Y contains links to lower pages y1 and y2:

| | |
|---------|---------|
| X | Y |
| x1 x2 | y1 y2 |

In this example,

- (1) x1 must be retrievable by a single command from X, Y, x2, y1, and y2;
- (2) x2 must be retrievable by a single command from X, Y, x1, y1, and y2;
- (3) y1 must be retrievable by a single command from X, Y, x1, x2, and y2;
- (4) y2 must be retrievable by a single command from X, Y, x1, x2, and y1;
- (5) X must be retrievable by a single command from Y, x1, x2, y1, and y2; and
- (6) Y must be retrievable by a single command from X, x1, x2, y1, and y2.

The Examiner’s Answer argues that the limitations in claim 1 are “overstated”:

Thus, while applicant argues that “any structure title can be accessed based on a single command from any other page” the examiner argues that this feature is overstated. The examiners position is that while the claims recite access from “any” other page, “the accessing or viewing in the claim” actually requires multiple steps of mouse movement to access any other structure.

Examiner’s Answer, page 20, lines 5-9 (emphasis added). The Examiner’s Answer then proceeds to discuss selected examples from Applicant’s specification, with the apparent goal to show that the *single retrieval command* limitation should be read as *multiple retrieval commands*. Examiner’s Answer, middle of page 20 through middle of page 22.

The *single retrieval command* limitation is explicitly recited in claim 1: “the categorization structure enables a user viewing content of any category title in the categorization structure to retrieve content of any other category title in the categorization structure using a single retrieval command.” The Examiner’s Answer plainly argues that the words in claim 1 mean something other than what they appear to mean on their face and something other than is described in the specification. The Examiner’s Answer is quite direct about this point:

While the disclosure and the claim portrays accessing directly any other title, the simple point is that the user cannot access any other structure without making several menu selections along another path and may not know or see any title from any other title. Simply looking at figure 6a-6e shows this concept. Thus . . . the present application also does not specifically show viewing content from any other category title because not all of the titles are directly accessible from any other page without the user navigating via the mouse to other trees.

Examiner’s Answer, page 21 (emphasis omitted). The simple reply to this argument is that the rejection being appealed is under section 103, for alleged obviousness. The verbiage of the limitation in issue is plain on its face, Applicant did not expressly define *single* in the specification to mean anything other than the common sense meaning of this word, the prosecution history is devoid of any attempt to redefine this word, and consequently the word

must not be construed in a brand new way that contradicts its plain meaning and construes *single* to mean *multiple*.

Indeed, the above quoted language of the rejection appears to admit that “the disclosure and the claim portrays accessing directly any other title,” Examiner’s Answer page 21. This finding should have prevented assigning of a different meaning to the limitation in issue here. “[T]he words of a claim ‘are generally given their ordinary and customary meaning.’” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) (internal citations omitted).¹

In the Appeal Brief, we have demonstrated that Gennaro does not disclose or suggest that from a display of content of any title the user can retrieve the content of any other title. With reference to Figure 3B, for example, Gennaro does not teach that page 56 has a link to any other page; or that page 54 has links to pages 58 or 52. And page 52 does not have a direct link to page 58.²

The Examiner’s Answer also argues (pages 22 and 23) that the categorization structure of claim 1 need not have more than two levels. This is true for claim 1,³ but irrelevant. Gennaro does not disclose or suggest retrieval of content of every page in the categorization structure using a single retrieval command, even when limited to two levels. Gennaro, Figure 3B.

The Examiner’s Answer goes on to argue that

Gennaro teaches accessing the menu structures without linking to new pages by repositioning the pointer over each hot spot, which would allow the user to access “any other” title in the menus of Gennaro simply by moving the cursor

¹ Whether or not claim 1 meets the requirements of section 112 is not in issue on this Appeal, but we briefly address this issue under the last subheading of the Argument section.

² There are additional examples in the Appeal Brief, pages 15 and 16.

³ Claim 2 explicitly recites at least three levels.

over the hotspots and not until the user selects the menu item, will the content be retrieved, as shown in steps 82 and 84 of Figure 4, as referred to in the final action, See page 4, middle).

Examiner's Answer, bottom of page 24. As we understand it, this is an argument that Gennaro allows accessing a second level of menus (under the hot spots, Figure 2B) from the initially displayed web page 40. Gennaro, however, fails to describe linking from the second level (or any other lower level) back to the top level. In other words, even if we consider solely the top level (web page 40) and the second level under the hot spot menus, Gennaro fails to disclose or suggest a categorization structure that enables a user viewing content of any category title (which must include the second level) to retrieve content of any other category title (which must include the top level) using a single retrieval command. Gennaro also fails to disclose or suggest enabling a user who is viewing one page of the second level (under one of the hot spots) to retrieve any other page on the same (second) level.

Turning next to the second reference, according to the Examiner's Answer, "the Examiner relied on Chang simply for the feature of modifying Gennaro to display substantially all of a website," Examiner's Answer, page 25. This is a curious proposition, because the words "web," "Internet," "www," and "http" are apparently absent from the Chang reference.⁴ Chang does not disclose a website.

In the Appeal Brief (page 16) we presented a concise argument why Chang also fails to remedy Gennaro's failure to disclose enabling a user viewing content of any category title in the categorization structure to retrieve content of any other category title in the categorization

⁴ Searches for these words were performed electronically.

structure using a single retrieval command. The Examiner's Answer now contends (pages 25-26) that Chang does exactly that.

In Chang, a word is selected and a principal dialog box is created. *See, e.g.*, Chang, col. 6, line 38 through col. 7, line 32. The principal dialog box can have icons that indicate the availability of subordinate dialog boxes. *Id.* A subordinate dialog box can have other icons that open subordinate dialog boxes of a lower level (*i.e.*, dialog boxes subordinate to the subordinate dialog box), and so forth. *Id.*⁵ Chang's subordinate dialog boxes appear to be transitory, disappearing when the pointer is moved away from the subordinate dialog box and all of its subordinate dialog boxes. Chang, col. 7, lines 2-32; *id.* col. 9, lines 34-64; *id.* col. 12, lines 34-38. In other words, no two subordinate dialog boxes at the same level or in different paths apparently can be open – or viewed – at the same time. We do not maintain that in accordance with our claim 1 a user must necessarily view two titles at the same time. We do maintain that the transitory nature of Chang's subordinate dialog boxes prevents a user viewing one subordinate box from viewing another subordinate box at the same level or in a different path.

Chang fails to disclose or suggest the recited categorization structure.

B. A New Ground of Rejection Under Section 112 Would Be Inappropriate Under the Circumstances

As noted above, the Examiner's Answer appears to suggest that a new ground of rejection under section 112 should be entered. See note 1 *supra* and the accompanying text. While the Board has discretionary power to enter a new rejection, we respectfully submit that a

⁵ This is a very brief description based on the understanding of the undersigned.

new rejection under section 112 would be inappropriate here, for several distinct reasons.⁶ First, “an appeal is just that – an appeal. The review authorized by 35 U.S.C. § 134 is not a process whereby the examiner and the applicant invite the [B]oard [of Patent Appeals and Interferences] to examine the application and resolve patentability in the first instance.” *Ex parte Braeken*, 54 USPQ2d 1110, 1112 (BPAI 1999). The Board “is basically a board of review – [it] review[s] . . . rejections made by patent examiners.” *Ex parte Gambogi*, 62 USPQ2d 1209, 1211 (BPAI 2001). This case has had a long and tortuous history, including eight rejections and a previous appeal.⁷ Surely there was plenty of time to decide on the proper grounds of rejection without asking the Board to do so in the first instance.

Second, the assertion in the Examiner’s Answer that the feature of retrieving with one single command is “overstated” is baseless. The specification teaches, for example, that “[t]he category structure of the present invention, although resides with the webpages, does not need to be displayed on the computer viewing screen with the rest of the page content, until specifically called for.” Specification, page 17, lines 16-18 (emphasis added). Therefore, the category structure does not need to be downloaded or retrieved – it already resides with the webpages. It is part of the webpage content.

⁶ We present only two reasons, because a rejection under section 112 is not in issue here. We do not wish to waive additional reasons and arguments, in case a rejection under section 112 is entered in the future.

⁷ Rejections were issued on 2/24/2006, 8/11/2006, 2/6/2007, 8/9/2007, 4/2/2008, 9/11/2008, 3/31/2009, and 12/1/2009. An appeal brief was filed on 1/8/2008, in response to which prosecution was reopened.

IV
CONCLUSION

For the foregoing reasons and the reasons given in the Appeal Brief, Applicant-Appellant respectfully submits that all pending claims are patentable over the cited references and requests reversal of the rejections.

Respectfully submitted,

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